

REMARKS

Claims 1, 3-16 and 26 are pending, and Claims 10-16 are withdrawn. In the Advisory Action mailed May 10, 2006, the Examiner has maintained the following rejection from the Final Office Action mailed March 2, 2006:

- 1) Claims 1 and 3-9 stand rejected under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement.

Applicant is of the understanding that the Examiner has entered the amendment to Claim 10 of the Response submitted May 2, 2006. No amendments to the Specification or claims are being made at this time.

1) The Claims Are Enabled

The Examiner has rejected Claims 1 and 3-9 under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement. Specifically, the Examiner has posed numerous questions regarding the nature of the claimed invention. Applicant respectfully disagrees that the claims lack enablement, and hereby systematically addresses the questions posed by the Examiner in the Final Office Action per the criticisms of the instant Advisory Action.

A. The Screen Supports The Tiles In A Vertical Plane While The Grid Orders The Tiles In A Horizontal Plane

In the Final Office Action, the Examiner states that "Claim 1 recites that the screen is suitable for supporting said plurality of tiles however, page 7, line 21 states that the grid shown in Figure 1 is designed to hold square tiles. Which is it? Does the screen hold the tiles or does the grid hold the tiles?" Moreover in the Advisory Action the Examiner states that the Response submitted May 2, 2006:

contains conjecture to supply deficiencies of the specification. For example, applicant states that the description states that both the grid and the screen hold the tiles. However, the portion of the [specification] that applicant recites does not specifically mention the "screen" for holding (Advisory Action).

In the Response submitted May 2, 2006, Applicant had chosen not to repeat verbatim the support for the term “screen” cited in the Response submitted February 14, 2006. As Applicant was criticized for this omission, Applicant reiterates that the term “screen”

refers to a protective covering that acts as a *support, and leveler*, and through which a vacuum is applied to the front surfaces of a plurality of tiles through a plurality of holes (Specification, paragraph [0021], *emphasis added*).

Likewise, Applicant teaches that the term “grid”

refers to a tool or tools comprising a plurality of slots or voids, for *ordering* a plurality of mosaic tiles to form a mosaic. The grid of the present invention also *stabilizes* the mosaic tiles such that the order is preserved until the mosaic tiles are irreversibly attached to a backing (Specification, paragraph [0020], *emphasis added*).

In short, the figures, definitions and description of the application as filed teach that both the screen and the grid temporarily immobilize the mosaic tiles on all but the bottom surface of the tiles (e.g., for square tiles, the screen supports the top surface of the tiles while the grid holds or supports the four side surfaces of the tiles). Thus one skilled in the art would appreciate from the teaching of the application as filed, that the grid “holds” or “orders” the mosaic tiles in a horizontal plane, while the screen provides a “support” upon which the mosaic tiles rest in a vertical plane.

B. The Slots Are Narrow Openings In the Grid For Ordering A Plurality of Tiles Upon Which A Negative Pressure Is Applied

In the Final Office Action the Examiner asks “[w]hat is the nature of the ‘slots’ in the grid? [H]ow does the vacuum related to both the holes and the slots?” Applicant wishes to remind the Examiner that claim terms such as “slots” and “voids” which are not defined in the Specification are to be given their “plain meaning.” In particular, “[o]rdinary English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say” (MPEP, 2111.01). Thus, the term “slots” should be

interpreted as narrow openings or grooves, while the term “voids” should be interpreted as empty areas or spaces (See, e.g., Merriam Webster Online Dictionary).

Moreover, the Examiner states that Applicant’s contention that “the slots extend completely through the grid...is conjecture since the [specification] does not similarly say this (Advisory Action). Applicant respectfully submits that the slots are narrow openings extending through the grid as taught in the figures, definitions and description of the application as filed. In particular, Applicant teaches that the term

"design template" refers to a diagram of the mosaic that is used as an aid for ordering a plurality of tiles in a grid. In preferred embodiments, the design template comprises a colored sheet that is visible through the slots in the grid and which dictates the color, texture or type of tile to place in each slot of the grid (e.g., red tiles placed in slots covering red areas of the design template, patterned tiles placed in slots covering stippled areas of the design template, etc.) (Specification, paragraph [0019].

Similarly Figure 1 B clearly illustrates that the holes of the screen are visible through the slots of the grid when the grid and screen are properly aligned. Likewise, Figure 2A clearly illustrates that the design template is visible through the slots of the grid when the grid is placed atop a representative design template. In contrast if the slots of the grid did not completely extend through the grid as the Examiner contends, the holes of the screen would *not* be visible when the screen and grid are aligned, and the design template would *not* be visible when the grid and design template are aligned.

Furthermore, Applicant teaches that

mosaic tiles are then placed into the grid 11 in the pattern chosen, if any, and in accordance with the underlying template if any. The finished surfaces of the mosaic tiles are placed down into the grid and registered with the specific surface (usually flat) under the grid. ... If the tiles were placed in the grid on a separate work surface, then the grid-mosaic tile assembly is moved to the top of the screen at which time the design template and/or temporary support is slipped out from under the mosaic tiles without disturbing their placement in the grid. ... A vacuum is applied to the top or finished surfaces of the mosaic tiles through the tank and screen (Specification, paragraphs [0043-0045]).

In contrast if the slots of the grid did not completely extend through the grid as the Examiner contends, then the vacuum applied through the holes of the screen would not be applied to the top or finished surfaces of the mosaic tiles ordered in the grid.

C. The Grid Is Held Together By Borders or Frames Surrounding The Plurality Of Slots Of The Grid

In the Final Office Action, the Examiner states that “Figure 1 shows that grid 11 has a cross hatching pattern. What does that mean insofar as slots are concerned? If one manufactures cross-hatched slots that extend completely through a sheet by a stamping process wouldn’t that cause the whole grid plate to fall apart into little squares? Do slots extend from the top of the grid to the bottom of the grid so that vacuum passes through the slots? If so how does one make intersecting slots so that the material of the grid does not disassemble?” Applicant respectfully submits that the inner area of the grid 11 of Figure 1A *is not* a cross-hatched pattern representing a single large void as interpreted by the Examiner. If it were so, the plurality of horizontal and vertical lines representing the frames of the slots of the grid would not be shown in Figure 1B, which depicts the grid aligned atop the screen or in Figure 2A, which depicts the grid placed atop a design template. Moreover if it were so, the grid of the present invention would be defined as consisting of a single slot or void, and not as comprising plurality of slots or voids per the definition section of the Specification.

Per the Advisory Action “[i]t is the examiner’s position that if one used a razor blade and made intersecting slots on paper and even left a border that what would be left is a pile of separate unconnected square pieces of paper and a border with nothing in it.” Applicant contends that the Examiner’s interpretation of the plurality of slots of the grid of Figures 1 and 2 as “intersecting slots” is incorrect and unfounded. Rather, Applicant’s contend that it is the frames or borders surrounding the plurality of slots that intersect in Figures 1 and 2. In fact, as shown in Figures 2B and 2C, the horizontal and vertical lines within the grid (e.g., frames or borders) have a width corresponding to the mortar or grout space of the finished mosaic tile sheet. Thus from the figures and Specification one skilled in the art would understand that the grid is held together by the small intersecting

frames separating the slots in the grid and by the large frame surrounding the plurality of small frames and slots.

D. The Screen Comprises At Least One Hole Per Slot Of The Grid

In the Final Office Action the Examiner asks “[w]hat does it mean that the slots correspond to holes? Is this meant in a vacuum sense? Does vacuum passing through a hole also pass through a slot? Is there one slot for every hole?” In addition, the Examiner states “[w]ith regard to the confusion by the phrase ‘slots correspond to holes’ applicant quotes a paragraph that neither mentions holes or slots” (Advisory Action). Applicant notes that the Examiner failed to consider Applicant’s argument that Figure 1B clearly teaches that the phrase “plurality of holes corresponding to said plurality of slots of said grid” means at least one hole per slot. In particular, Figure 1B illustrates that each slot of the grid corresponds to a hole of the screen (e.g., 121 slots atop 121 holes).

Applicant respectfully submits that the quoted paragraph was provided to address the Examiner’s apparent confusion regarding the relationship of the vacuum to tiles resting within the grid resting atop the screen. Applicant reiterates this teaching in reply to the Examiner’s question regarding where the vacuum goes (Advisory Action). Specifically, Applicant teaches that a:

vacuum is applied to the top or finished surfaces of the mosaic tiles through the tank and screen, via a suitable pump 15 and tubing 14. This causes the individual mosaic tiles to register with the screen, which causes all finished faces of the mosaic to be leveled in the same place (or whatever curvature is desired and determined by the design of the screen and matching grid) regardless of what may be varying thicknesses of the different individual mosaic tiles (Specification, paragraph [0045]).

Thus, Applicant contends that one skilled in the art would appreciate from the Specification and the exemplary embodiment depicted in Figures 1A and 1B, that the claimed apparatus comprises at least one hole for every slot for channeling a negative pressure to each mosaic tile contained in a slot.


E. Evidence As A Whole Indicates The Pending Claims Are Enabled

Applicant respectfully disagrees with the Examiner's statement of the Final Office Action that the "disclosure cannot be understood so that one skilled in the art can make and use the device." Moreover, Applicant disagrees with the Examiner's assertion of the Advisory Action that "one skilled in the art would not be able to make any sense from this specification and sketchy drawings." Applicant contends that the Examiner's personal opinion based on his lack of understanding of the embodiments of the pending claims does not equate with a lack of understanding by skilled in the art. When taken together, the Specification and figures describing the actual reduction to practice of an exemplary embodiment of the claimed invention (e.g., working example) provide enabling support for the pending claims. Evidence that the pending claims are enabled is provided in multiple Declarations from individuals with experience in the mosaic and marbles industries (Artisan Declarations attached hereto at Tabs 1 - 3). As the preponderance of evidence clearly indicates that the pending claims are enabled, Applicant respectfully requests that this rejection be withdrawn.

CONCLUSION

Applicant believes the arguments and evidence provided herein traverse the Examiner's rejection and, therefore requests that a timely Notice of Allowance be issued in this case. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect.

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